

REMARKS/ARGUMENTS

In the present amendment, new claims 34-52 have been added to give a total of 33 claims with 9 independent claims. Before claims 11-29 were cancelled, the application contained a total of 33 claims with 9 independent claims, thus no fees for the new claims are needed as they have been previously paid. New claims 34-52 correspond to claims 1-10.

In the claim rejections of the office action, claims 1-4, 10, 31, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelmen et al. U.S. Patent 6,539, 421 (hereinafter Appelman in view of Robertson et al. U.S. patent 6,209,100 (hereinafter Robertson) in view of Beavers et al. U.S. Patent Publication 2004/0002049 (hereinafter Beavers). Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman, in view of Beavers, further in view of Robertson. Claims 5, 30, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman in view of Robertson, further in view of Beavers further in view of Kapil et al. U.S. Patent 6,941,345 (hereinafter Kapil). The rejections are traversed and reconsideration is respectfully requested.

Appelman discloses a messaging application user interface which has an input element for receiving electronic messages and an output element for displaying electronic messages. The messaging application user interface can be implemented so as to maintain a subset of the plurality of potential message recipients, the subset being determined using a predetermined criterion (see abstract). As described at Col. 4, lines 35-37: "the input element 14 can be text field or a command line prompt in which the user enters a message 16 having an address 18 for whom he message 16 is intended. . .". It is submitted that messages in Appelman are not directed from a first client to a second unidentified client as claimed, but that all of the messages in Appelman are as clearly shown in Fig. 15 as address 634 and Fig. having address fields 644 and 652 (see Col. 9, lines 32 and 46-47). Much of Appelman discloses completing partial addresses that are entered in the input element of a user interface using a subset of potential message recipients (see Col. 6, line 8-Col. 8, line 40).

Robertson discloses a method for moderating forums with anonymous but traceable contributions to the forum. An administrator is a person who sets up and maintains forums (see

Col. 1, lines 13-14). A moderator is a subject-matter expert appointed to monitor the messages being posted to a particular forum(see Col. 1, lines 23-24). In Robertson, the identity of the forum contributor is hidden from readers of the anonymous contributor's messages, but at the same time, is known to the moderator (see Col. 2, lines 40-42). "A method for anonymously posting a message to a moderated forum, which can be moderated despite the anonymous contribution, is illustrated in FIG. 1" (see Col. 5, lines 24-26).

In claims 1, 6 and 10, methods for electronic instant message conversation are claimed in which a second unidentified client receives a first message to be published from a first client, the first message related to a topic of interest. Claims 1 and 6 make clear that the same message related to a topic of interest is published to subscribers of the topic of interest. Thus, at this point, all subscribers receive the same message. Claims 1, 6 and 10 make clear that the messages are filtered at the second client such that only messages of specific interest to the second client are received by the second client. This is set out at paragraph [0014], "Message filters are employed to allow listeners to only be alerted to messages that contain content of interest." Also, in paragraph [0010] "coworkers who have elected to see SkillTap Instant Messages containing keywords of interest to them are presented an alert box with the message." At paragraph [0038] "receiving a request message from a channel of a pub/sub server; Filtering the request message by a filtering application according to subscriber criteria." At paragraph [0055], "One of these applications, App 2 provides filtering techniques on incoming messages to eliminate messages that are not of interest to the client 2." Also at paragraph [0062] "The filter defines the user's areas of interest or expertise."

As claimed, the second subscriber being a subscriber to the service of the pub/sub service as being willing to receive messages related to the topic of interest and being anonymous to the first client and other subscribers of the pub/sub service. Thus, subscribers to the service themselves establish the messages to be received and further filter the received messages for message of specific interest to them, and not an administrator as in Robertson, or the first user as in Appelman. This is not shown in Appelman or Robertson. Claims 1, 6 and 10 also claim "creating at the second message . . . including further information pursuant to said specific interest included in said first message message;". Questions and answers are shown in

Appelman, but those asking questions are always known to the answerer, and the answerer is always known to the questioner. In Robertson, a topic may be discussed which might include questions and answers, but the forum is established by an administrator, and not by subscribers who establish the topic and indicate a willingness to receive messages related to the topic, as claimed. It is submitted that claim 1, 6 and 10, and all claims depended therefrom, are allowable under 35 U.S.C. 103(a) over Appelman in view of Robertson, which allowance is respectfully requested.

The examiner states that it would have been obvious to one of ordinary skill in the art for subscribers being anonymous and the second client remaining anonymous to the first client and other subscribers after transmission of messages. The examiner has not cited art which shows or suggests this combination, but instead says “the motivation for doing so would be because the user/subscriber wants to remain anonymous to hide his/her identity therefore any post/messages the user/subscriber sends to the forum, the system would know the user’s actual identity, therefore the user can be traced if needed.” The applicant disagrees. There is no citation to any art that shows or suggests the combination wherein the second client remains anonymous to the first client and other subscribers. The examiner has only given a motivation for so doing, and even admits that the user’s actual identity might be traced, even though tracing is not part of any claim. It is submitted that the examiner must show teaching or suggestion in the prior art that the second client remain anonymous to the first client and the other subscribers rather than proposing a motivation. Further, there must be some teaching or suggestion that the references be combined in the claimed combination rather than finding the elements piecemeal and using the teaching of the present application to say that they can be combined.

It is submitted that Beavers is not a proper reference under U.S.C. 103. Beavers was published Jan. 1, 2004 on application 10/371,537 filed Feb. 21, 2003. Beavers claims the benefit of a previously filed provisional patent application 60/392,898 which was filed on Jul. 1, 2002. However, the specification of the provisional patent application 60/392,898 has been compared with the specification of the US 2004/0002049 A1, and the portion of Beavers relied on by the examiner (paragraph 233 and Fig. 25, paragraphs 237, 238, Fig. 29) to reject claims 1-4, 6-9, 10, 31, 33 does not appear in the provisional application. Therefore it is submitted that the effective filing date of that portion of Beavers cited against claims 1-10 is the filing date of Application

No. 10/371,537, Feb. 21, 2003. The present application 10/730,227 was filed on 12/08/2003 and is a divisional of US Patent Application Serial Number 10/207,285 which was filed July 26, 2002 (see paragraph [0002], CROSS-REFERENCE TO RELATED APPLICATION). Thus the effective filing date of the present application is before Beavers. Therefore, Beavers is not a proper reference against claims 1-10. "U.S. patents may be used as of their filing dates to show that the claimed subject matter is anticipated or obvious. Obviousness can be shown by combining other prior art with the U.S. patent reference in a 35 U.S.C. 103 rejection. *Hazeltine Research v. Brenner*, 382 U.S. 252, 147 USPQ 429 (1965). Similarly, certain U.S. application publications and certain international application publications may also be used as of their earliest effective U.S. filing dates (which will include certain international filing dates) to show that the claimed subject matter would have been anticipated or obvious." See MPEP 2136.02 III. Since the effective filing date of the portion of Beavers relied on by the examiner to reject claims 1-10, 30-33 and new claims 34-52 is later than the effective filing date of the present invention, it is submitted that the remaining claims are allowable, which allowance is respectfully requested.

Claims 2-3, 5-9 claims 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman in view of Robertson and further in view of US 6,209,100 to Kapil et al. (hereinafter Kapil). The examiner cites Kapil for teaching the first message is received at the second client from the first client by way of a publish/subscribe server. However in Kapil, the second client is known to the first client (see Col. 4, lines 17-19): "In this arrangement, user A on the terminal 12 may request a messaging or communications session with user B in the second community 16 . . .". (see also, Col. 4, lines 6-9). In Kapil, a communication session is established between a user A and user B before messages are sent (see Col. 4, line 34-49). As claimed, the first user publishes a message related to a topic of interest through a pub/sub service to unknown subscribers to are willing to receive messages related to the subject of interest. The messages to all of the subscribers are the same. However, each receiver of the message filters the message to find messages of specific interest to each subscriber. The unknown subscribers send a second message to the first user wherein the second message contains further information pursuant to said specific interest included in said first message. It is submitted that claims 2-3, 5-9, 30 and 32 are allowable under 35 U.S.C. over Appelman in view of Robertson and further in view of Kapil, which allowance is respectfully requested.

The examiner's attention is directed to U.S. Patent 6,574,658 B1 to Gabber et al. (hereinafter Gabber) abstract and column 2, lines 25-30. In Gabber, keyword filtering is used to recognize and remove spam messages. However, in the present claims, each message is filtered such that only messages of specific interest pass the filter to be presented to the second client. Thus, in Gabber, filters are used to stop message having certain keywords whereas what is claimed is filtering to present to the second client only those messages of specific interest. The examiner's attention is directed to Column 4, lines 19-29 of U.S. Patent 6,651,086 to Manber et al. (hereinafter Manber) wherein a user identifies or locates a story or topic of interest by conducting a topic or keyword search. However, in Manber, a story or topic of interest from various web pages is searched rather than a message from a first sending client which is identified by as being of specific interest to a receiving second client, as claimed.

It is respectfully submitted that the application is now in condition for allowance, which allowance is respectfully requested.

RESPECTFULLY SUBMITTED

/Floyd A. Gonzalez/

FLOYD A. GONZALEZ-Attorney

Registration No. 26,732

Phone: 845-433-7282

Fax: 845-432-9786